

REMARKS/ARGUMENTS

Claims 1-2 and 4-28 are currently pending in this application. In this Office action response, Claims 1, 2, 4-9, 11-17, 19-22 and 25-27 have been amended. Claims 29-33 have been added. Claim 3 was previously cancelled. Claims 18, 23-24 and 28 are cancelled herein. Claim 10 remains unchanged.

Interview and Follow-up Teleconference

Applicants' attorney thanks the Examiner for the telephone interview on January 6, 2010 and follow-up teleconference on January 11, 2010. In the interview, the Brown newspaper article was briefly discussed, proposed amended Claims 1, 2, 4-9, 11-17, 19-22 and 25-27 and proposed new Claims 29-33 were reviewed. The availability of the Allsup Express reference as prior art and the Declaration of Daniel J. Allsup were also discussed. The Examiner agreed that the objections and rejections under 35 U.S.C. §112 were overcome by the proposed amendments to the Claims, except for Claim 26. Claim 26 has been further amended herein to overcome the rejection under 35 U.S.C. 112.

Regarding the Allsup Express reference, as discussed more fully below, an agreement was reached that if Applicants could produce a written confidentiality policy covering Allsup Express, that the Allsup Express reference would likely be withdrawn as prior art. The concurrently submitted Declaration of Daniel J. Allsup

includes evidence of a written confidentiality policy that covers the information contained in the Allsup Express reference.

Claim Objections and Rejections under 35 USC §112

Applicants appreciate the careful review given the claims by the Examiner. In this amendment, Applicants have made considerable amendments to the claims in an effort to comply with the Examiner's objections and rejections under 35 USC §112. As noted above, the amendments to the Claims were discussed during the interview with the Examiner. As a result of the interview, it was determined that the amendments overcome the Examiner's objections and §112 rejections to the claims. Withdrawal of the claim objections and §112 rejections is respectfully requested. Should the Examiner have any further comments or concerns regarding the claim language, the Examiner is urged to call Applicants' undersigned attorney.

Claim Rejections - 35 USC §103

In this Office Action, the Examiner made the following rejections under 35 U.S.C. §103:

- Claims 1, 4, 26 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allsup, "Enter Workers' Compensation Savings" (*Allsup*) in view of Gil et al., Pub. No. 2002/0188513 (*Gil*);
- Claims 2, 5, 6, 12-15, and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Allsup* in view of *Gil* and further in view of

Daryle Glynn Brown, "Computer to weed out public housing cheats"
(*"Brown"*);

- Claims 7-11 and 16-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Allsup* in view of *Gil* and *Allsup-corpser.htm*, Web archive printout (*"Allsup-corpser"*);
- Claim 18 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Allsup*, *Gil* and *Allsup-corpser* and further in view of *Allsup Express*, "Allsup Employee Newsletter Article: Bank Transaction Builds Client Base" (*"Allsup Express"*);
- Claims 19-21 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Allsup* in view of *Brown*; and
- Claims 22-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Allsup* in view of *Brown* and Office Notice.

Applicants respectfully traverse the Examiner's rejection of the claims. As set forth below, the Claims as presented above are believed to be in condition for allowance.

The Examiner contends that *Gil* teaches:

- "a method [for] reporting in a supply chain involving an enterprise (Applicants' third party) and at least one partner (Applicants' service provider). *Gil* teaches that the enterprise can request access to real-time data stored in the partner's system, wherein the real-time data relates to a transaction in which the partner is involved. *Gil* teaches that the method converts the real-time data into a usable format usable and

- provides the data over a network to the enterprise". (Office Action, p. 13)
- "that vertically integrated, centrally managed business models are rapidly giving way to decentralized business models leveraging outsourcing and that the rationale behind outsourcing is simple: focus on core competencies, and for everything else, transfer responsibility to various types of service providers (or "partners") who can employ economies of scale and provide geographic coverage for product distribution, service, and manufacturing" (Office Action, p. 15)
 - "the use of a graphical user interface (GUI)". (Office Action, p. 15)

Applicants respectfully disagree with the Examiner's assertions. The system of Gil is directed to the vertical integration of a supply chain rather than the recovery of an overpayment such as Applicants' service. There are substantial differences in the design and implementation of a vertical integration of a supply chain as compared to the implementation of an overpayment recovery system. These differences are sufficiently great that one of ordinary skill in the art in designing an insurance overpayment recovery system, such as Applicants' system, would not turn to, and would not be expected to turn to, a system which vertically integrates a supply chain, as disclosed in Gil. Hence, Applicants, respectfully submit that Gil is not analogous prior art. Even if the Examiner should continue to assert that Gil is prior art, as discussed below, the claims as set forth herein are allowable over *Gil*.

Claims 1, 4, 6-8, 12, 16, 17, 19 and 26 have been amended to include the step of "verifying, by the service provider, that the disabled individual's deposit account has sufficient funds to cover a withdrawal of the predetermined amount of overpaid benefits" or similar language. Support for this amendment can be found in

the Specification on page 29, lines 6-13. None of *Gil*, *Brown* and *Allsup-corpser* teach or disclose such a “verifying” step. For a claim to be obvious under 35 U.S.C. §103, the references must disclose or otherwise make obvious *all* of the elements of the claim. At least this noted element is not taught, suggested, or otherwise made obvious by any of the references cited by the Examiner. Thus, for at least this reason, Independent Claims 1, 4, 6-8, 12, 16, 17, 19 and 26, as set forth above, are allowable over any combination of those references.

Claims 2, 5-7, 11-12, 19, 25, and 27 have been amended to include the step of “the service provider electronically receiving information regarding the predetermined amount from the third party” or similar language. Support for this amendment can be found in the Specification on page 31, line 18 through page 32, line 4. The Examiner contends that *Brown* teaches that one entity calculates an overpayment, while a second entity handles the collection of an overpayment. However, *Brown* does not teach or disclose any method as to how the calculating entity communicates with the collecting entity. The Examiner only surmises that the calculating entity communicates the information to the collecting entity. Further, at least Claims 5-7, 11, 25, and 27 provide that the client has access to a computer program or database hosted by the service provider through which the client can transfer the information regarding the overpayment amount to the service provider. *Brown* does not disclose any such computer program which can facilitate such

communication from the client to the service provider. Applicants thus respectfully submit that neither *Brown*, nor any of the other references relied upon by the Examiner teach, suggest, or otherwise make obvious, the step of electronically receiving the information related to the amount of the overpayment from the client, and especially do not teach, suggest, or otherwise make obvious the step of providing the client with access to a computer program through which the information relating to the overpayment amount can be submitted by the client to the service provider. Thus, Claims 2, 5-7, 11-12, 19, 25, and 27, as set forth above, are allowable over *Brown* combined with any other reference cited by the Examiner.

Further, Claims 2, 5, 11, 25 and 27 depend from Claims 1, 4, 8, 19, and 26 respectively, and are also believed to be allowable for at least the reasons stated above in conjunction with Claims 1, 4, 8 and 19 and 26.

As set forth above, each independent claim includes one or both of the “verifying” step and the “receiving information step”. Further, many of the dependent claims (either explicitly and/or by virtue of their dependence from an independent claim) include one, or both, of the noted steps. As discussed above, neither of these steps are disclosed or made obvious by the references cited by the Examiner.

The subject matter of Claim 18, which is cancelled herein, has been incorporated into Claim 17. Claim 18 was rejected in part over Allsup Express.

Applicants respectfully submit that the Allsup Express is not properly prior art with respect to this application.

A given reference is a "printed publication" if it was "publicly accessible" during the prior art period. *Bruckelmyer v. Ground Heaters, Inc.*, 445 F. 3d 1374, (Fed. Cir. 2006). A given reference is "publicly accessible"

upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.

Id. (citing *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)); MPEP §2128. Documents and items only distributed internally within an organization which are intended to remain confidential are not "printed publications" no matter how many copies are distributed. MPEP §2128.01, III. There must be an existing policy of confidentiality or agreement to remain confidential within the organization. *Id.*

As shown by the Declaration of Daniel J. Allsup ("the Declaration"), submitted contemporaneously with this Amendment, Allsup Express was an internal company newsletter designed to provide information about company policies and programs and was produced solely for distribution to, and use by, Allsup, Inc.¹ employees. Further, the Declaration contains pertinent pages from Allsup's employee handbook,

¹ Allsup, Inc. (Allsup) is the assignee of this application.

which is distributed to all of Allsup's employees, which shows that the employees are expected to protect confidential information and trade secrets of Allsup including knowledge and information concerning Allsup's services, customers, business operations and technical details of Allsup's business and the services rendered by Allsup. Thus, the *Allsup Express* is a confidential publication for internal use only. MPEP §2128.01, III. Additionally, the Declaration shows that the September 1999 issue of Allsup Express was distributed to Allsup employees in printed form only and that Allsup has not cataloged or indexed, or caused to be cataloged or indexed, any issue of Allsup Express (including the September 1999 edition of the Allsup Express newsletter) in any publically available catalog or index. Thus, one skilled in the art, no matter how diligent, would to be unable locate *Allsup Express*. Therefore, for at least these two reasons, *Allsup Express* does not qualify as prior art as a printed publication. In view of the fact that *Allsup Express* does not qualify as prior art, the subject matter of Claim 18 is allowable. As noted, the subject matter of Claim 18 has been incorporated into Claim 17 (and Claim 18 has been canceled). Applicants thus submit that Claim 17 as amended is allowable over any combination of the references cited by the Examiner.

New Claims

Claims 29-33 have been added. Claim 29 is an independent claim that includes the subject matter of amended Claim 17 without the "providing access"

limitation from original Claim 17, which was objected to by the Examiner. Claim 29 thus includes no new matter. Claim 29 is allowable for at least the reasons stated above regarding Claim 17.

Claim 30 depends from Claim 11 and adds a step of “notifying the third party if information regarding the amount of overpaid benefits to be captured is still required in order to recover the amount of overpaid benefits.” Claim 31 depends from Claim 16 and provides that the “software instructions being executed by the computer processor notify the third party if information regarding the amount of benefits to be captured is still required in order to recover the amount of overpaid benefits.” This “notifying” step or function is disclosed at page 30, lines 19-20 and page 32 lines 14-17 of the specification and is shown in Fig 13. Hence, Claims 30 and 31 do not add new matter to the application. Claims 30 and 31 are allowable for at least the reasons stated above for Claims 11 and 16. Further, none of the references are believed to disclose a step of the service provider notifying the third party client that further information is required in order to recover the amount of overpaid benefits. Hence, Claims 30 and 31 are believed to be allowable for this additional reason.

New Claim 32 depends from Claim 4 and provides a further step of “electronically notifying the client that the recovery was made.” Support for this step can be found at page 29, lines 9-10, of the specification, and thus does not add new matter to the application. Initially, Claim 32 is allowable in view of its dependency

from Claim 4. Further, none of the references are believed to teach or suggest this additional step. Hence, Claim 32 is allowable for this further reason.

Lastly, new Claim 33 depends from Claim 17 and further delineates how the fee is deducted. Claim 33 provides a further step of “deducting applicable fees from the calculated overpayment recovered from the claimant’s deposit account.” This is to be compared, for example, with deducting the fee from the claimant’s account in a first withdrawal from the claimant’s account and then withdrawing the remainder of the overpaid amount (i.e., the overpaid amount less the fee) from the claimant’s account in a second transaction. Support for the subject matter of Claim 33 is shown, for example, in FIG. 3, wherein after the money is swept from the claimant’s account, the overpayment less the fee is forwarded to the client. Claim 33 is allowable at least in view of its dependency from Claim 17.

Appl. No. 10/785,473
Filed: February 24, 2004
Amendment dated January 15, 2010

Conclusion

In view of the forgoing, Claims 1, 2, 4-17, 19-22, 25-27 and 29-33 are submitted to be in condition for allowance. Applicants thus respectfully request that the Examiner withdraw the objections and rejections to the Claims, and issue an allowance with respect to Claims 1, 2, 4-17, 19-22, 25-27 and 29-33.

You are hereby authorized to charge payment of an extension fee associated with this communication or credit any overpayment to Deposit Account No. 162201.

Respectfully Submitted,

Dated: January 15, 2010

/steven c balsarotti, reg. no. 65601/
Steven C. Balsarotti, Reg. No. 65,601
Polster, Lieder, Woodruff & Lucchesi, L.C.
12412 Powerscourt Drive, Suite 200
St. Louis, Missouri 63131
Tel: (314) 238-2400
Fax: (314) 238-2401
e-mail: sbalsarotti@patpro.com